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DATE: April 23, 2003

FROM: C. Eric Schulman

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To:

NAME	COMPANY	BUSINESS #	FAX #
Examiner Sabrina Chang			703-305-7687

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**DATE:** April 23, 2003

**FROM:** C. Eric Schulman

**CLIENT:** Music Choice

*Direct Dial 617 348 3005  
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Attorney No.

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Client No.

14688

Matter No.

504

**To:**

NAME	COMPANY	BUSINESS #	FAX #
Examiner Sabrina Chang			703-305-7687

**MESSAGE:**

**PLEASE SEE ATTACHED SUMMARY OF INTERVIEW.**

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*Howan*  
*5-2-03*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Jeremy Rosenberg  
SERIAL NUMBER: 09/547,846 EXAMINER: S. Chang  
FILING DATE: April 12, 2000 ART UNIT: 3625  
FOR: CROSS CHANNEL DELIVERY SYSTEM AND METHOD

April 10, 2003  
Boston, MA 02111

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

The undersigned hereby certifies that this document is being facsimile transmitted to Commissioner for Patents, Washington, D.C. 20231 at fax number 793 746 3058.

*Mary McCarty*  
Signature of Person Mailing

Commissioner for Patents  
Washington, DC 20231

SUMMARY OF INTERVIEW AND REQUEST FOR WITHDRAWAL  
OF FINALITY OF MARCH 8, 2003 OFFICE ACTION

Dear Madam:

Applicant wishes to thank Examiner Chang for the courtesy of conducting the interview of April 9, 2003 with regard to the above-referenced application. It is the Applicant's understanding that Examiner Chang requested that the Applicant submit a written request for the withdrawal of finality of the March 28, 2003 Office Action issued in the present case and that the Applicant submit a copy of the Applicant's last response filed October 17, 2002. Accordingly, the Applicant requests withdrawal of finality of the March 28, 2003 Office Action given that the Office Action adds a new ground of rejection to unamended claims (MPEP 706.07(a)). More specifically, the Office Action adds a new reference, i.e., U.S. Patent No. 6,233,692 issued to Fritsch, to the 35 USC §103 rejection of unamended claims, e.g., claims 1 and 10. This submission is made in response to the Examiner's request. The Applicant reserves the opportunity to file a Response to the March 8, 2003 Office Action in due course.

Applicants: Jeromy Rosenberg  
U.S.S.N. 09/547,846

In addition, per the Examiner's request, the Applicant provides the attached copy of the Applicant's October 17, 2002 Response.

The Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 14688-504.

Respectfully submitted,



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TRA 1783879v1

Express Mail Label No.: EV139503718US  
Date of Deposit: October 17, 2002

Application No. 09/547,846  
Filed: April 12, 2000  
Group Art Unit: 3625

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application : Jeremy Rosenberg  
Application No. : 09/547,846  
Filed : April 12, 2000  
For : CROSS CHANNEL DELIVERY SYSTEM AND METHOD  
Attorney's Docket : 14688-504

Group Art Unit: 3625

Amendment A

Box Non-Fee Amendment

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action mailed July 17, 2002, please amend the above-referenced application as follows:

In the Claims

Please amend claims 15-18 as follows (as required by 37 CFR §1.121(c), a clean copy of each of the amended claims is set forth below and a marked-up copy of each of the amended claims is set forth in an Appendix entitled Version of Claim Amendments with Markings to Show Changes Made);

CLAIMS

15. (Amended) The system of claim 11, wherein the fulfillment system communicates with consumers using multiple transmission mediums.

16. (Amended) The system of claim 15, wherein the storing means further stores information relating to a consumers access to multiple transmission mediums.

17. (Amended) The system of claim 11, wherein each remote device comprises: storing means for storing a set of previously broadcasted messages for a predetermined period of time.

18. (Amended) The system of claim 11, wherein the remote device is a set-top box.

19. (New) A fulfillment system for use in transmitting items to devices associated with purchasers, comprising:

a transmission component operative to transmit broadcast messages to, and receive purchase instructions from, remote devices associated with remote consumers;

secondary storage device in communication with the transmission component, the secondary storage device operative to store information correlating the remote devices associated with the remote consumers with a set of remote devices associated with the consumers; and

clearinghouse software in communication with the secondary storage, the clearinghouse software operative to transmit, by a transmission medium different from the broadcast medium, items to the set of remote devices associated with the consumers in response to the received purchase requests and based on the correlation information stored in the secondary storage device.

20. (New) The system of claim 19, wherein the secondary storage device includes: at least one table including an identifier for each remote device and data indicating a delivery address for transmitting item to the set of client devices associated with the consumers in response to the received purchase requests.

#### REMARKS

In response to the Office Action mailed July 17, 2002, Applicants respectfully request consideration of the amendments above and allowance of the application. Applicants have amended claims 15-18 to make a minor correction, i.e., to replace "method" with "system" in the first line of each claim. Applicants have also added claims 19 and 20. One can find support for the new claims, through out the specification including between page 8, line 22 and page 9, line 21 and with reference to Fig. 9. Thus, claims 1-20 are currently pending. The amendments above do not introduce new subject matter.

35 USC § 103

Reconsideration and withdrawal of these obviousness rejections is deemed in order and requested.

The Claimed Invention

Methods and systems according to the claimed invention provide a cross channel fulfillment system that enables consumers to purchase and receive items using different transmission mediums. The fulfillment system is a centralized distribution system that maintains information relating to consumers and has access to multiple transmission mediums. Specifically, the fulfillment system contains a database of consumer contact information relating to each transmission medium. The fulfillment system uses a remote device to provide information to consumers. The remote device transmits and receives broadcast messages including information relating to purchasable items. The fulfillment system may deliver a purchased item to the consumer using a medium different from that used to purchase the item.

Claims 1-8, 10-16, and 18

Claim 1 provides a method for automatically and electronically purchasing items in a network. The network includes: a fulfillment system configured to broadcast messages identifying purchasable items; and a set of remote devices configured to receive the broadcast messages and enable consumers to view information reflecting the purchasable items and to select purchasable items. The fulfillment system receives instructions identifying selected purchasable items and provides purchasable items to the consumers.

The method includes: *receiving at each remote device a broadcast message identifying a purchasable item*, wherein the broadcast message is transmitted from the fulfillment system to the remote devices using a transmission medium; *permitting information corresponding to the broadcast message to be presented to the consumers*; *receiving an instruction at a particular one of the remote devices associated with one of the consumers, wherein the instruction indicates the consumer's request to obtain a purchasable item*; *transmitting information from the particular remote device to the fulfillment system, wherein the transmitted information reflects the received instruction*; and *providing, by the fulfillment system to a device associated with the consumer associated with the particular remote device at which the instruction was received, the*

*purchasable item using a transmission medium different from the transmission medium used for the broadcast message.* [emphasis added].

Contrary to the assertion in the July 17, 2002 Office Action that under 35 U.S.C. 103(a) claim 1 is unpatentable over U.S. Patent No. 5,878,141 issued to Daly (hereinafter Daly) in view of Schlasberg PCT no. WO 99/17320 (hereinafter Schlasberg), there is no motivation to combine the cited documents to achieve the claimed invention. The Examiner acknowledges that Daly does not disclose "providing, by the fulfillment system to a device associated with the consumer associated with the particular remote device at which the instruction was received, the purchasable item using a transmission medium different from the transmission medium used for the broadcast message," as claimed. At a minimum, Schlasberg does not disclose: "receiving at each remote device a broadcast message identifying a purchasable item, wherein the broadcast message is transmitted from the fulfillment system to the remote devices using a transmission medium;" and "permitting information corresponding to the broadcast message to be presented to the consumers," also as claimed in claim 1.

The Federal Circuit has stated that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." See *In re Geiger* 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

The July 17, 2002 Office Action, on page 4, notes the following:

[I]n that the system of Daly already allows the user to select their method of payment from a plurality of stored options, it would have been obvious to further modify the system to allow the customer to choose their method of delivery from a database storing their delivery options, as taught by Schlasberg, to allow the customer to receive their purchase anywhere in case the user device they are ordering from has limited information receiving capability [Schlasberg, Page 8, Line 1].

However, the fact that Schlasberg notes that a user device for his invention will often be a device with limited information receiving capability does not provide a suggestion to combine the teachings of Daly with those of Schlasberg to obtain the invention as claimed. In fact, the paragraph referenced in Schlasberg, i.e., the paragraph starting on page 7, line 30 reads as follows:



The information receiving address selected by the user can also be the address of the user device from which the message is sent. This could be the case when the information is needed immediately. However, in the preferred embodiment the information receiving address is associated with an information receiver other than the user device from which the request message is sent, because the user device will often be a device with limited information receiving capability, *if any*. [Emphasis added].

Indeed, rather than suggest the combination, Schlasberg teaches away from the combination. In particular, Schlasberg teaches away from combining: 1) *receiving at each remote device a broadcast message identifying a purchasable item, wherein the broadcast message is transmitted from the fulfillment system to the remote devices using a transmission medium*; and permitting information corresponding to the broadcast message to be presented to the consumers with 2) *providing, ..., the purchasable item using a transmission medium different from the transmission medium used for the broadcast message*, as claimed, because: a) he notes that the user device, i.e., the remote device of claim 1, may not have *any* information receiving capability; and b) Schlasberg describes his invention in terms of information and information seekers (See page 2, lines 5-10).

More specifically with respect to reason (a) above, one of skill in the art at the time of the invention would not be motivated to combine 1) *receiving at each remote device a broadcast message identifying a purchasable item* with 2) *providing, ..., the purchasable item using a transmission medium different from the transmission medium used for the broadcast message* if the person of skill in the art believes the remote device has no information receiving ability as Schlasberg states may be the case.

More specifically with respect to reason (b) above, Schlasberg uses an instance where an individual finds an interesting article in a magazine or an interesting advertisement for a product and then needs to remember the information as an example of the utility of his invention (see page 1). Indeed, the transmitting devices taught by Schlasberg each appear to include a bar-code reader or similar device for obtaining an identification for an article or product of interest (See Figs. 3 and 4 and associated text) so that the user does not need to remember identifying information for the article of interest. Such a disclosure, e.g., the noted problem and the disclosed devices with a bar-code reader or similar device, teaches away from receiving a broadcast message as claimed because when a user receives a broadcast message identifying a purchasable item, the user does not need to remember anything. Thus, one of skill in the art at

the time of the invention would not be motivated by the problem Schlasberg was trying to solve, difficulty in remembering identifying details regarding an article of interest, to combine the teaching of Schlasberg with the teaching of Daly to achieve the claimed invention. In other words, receiving at each remote device a broadcast message identifying a purchasable item, as claimed, does not solve the problem identified by Schlasberg of having to remember identifying information regarding an article of interest, e.g., an article in a magazine read while traveling on an airplane.

Claims 10 and 19 include limitations similar to claim 1. Furthermore, claims 2-8 depend from claim 1 and claims 11-16 and 17 depend from claim 10. Therefore, at least for the reasons cited above, claims 1-8, 10-16, and 18 are patentably distinct over Daly in view of Schlasberg and the rejection of claims 1-8, 10-16, and 18 under 35 USC 103 as unpatentable over Daly in view of Schlasberg is traversed.

Claims 9 and 17

Claim 9 provides the method of claim 1 wherein each remote device maintains a set of previously broadcast messages for a predetermined period of time. Contrary to the assertion in the July 17, 2002 Office Action that under 35 U.S.C. 103(a) claim 9 is unpatentable over Daly in view of Schlasberg in further view of "Set-top box for television that reads your mind," (Taylor, Paul, December 30, 1998, Financial Times) (hereinafter Set-top box), there is no motivation to combine the cited documents to achieve the claimed invention. The Examiner acknowledges that *neither "Daly nor Schlasberg discloses that a system wherein the remote device maintains a set of previously broadcasted messages for a predetermined time."* [Emphasis added]

As noted above, the Federal Circuit has stated that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." See *In re Geiger* 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

The July 17, 2002 Office Action, on page 5, notes the following:

"Set-top box" teaches a system wherein an interactive remote device receives broadcasts from a central location and stores the broadcasts for a predetermined time. It would have been obvious to modify the system of Daly et al and Schlasberg to include the ability to store broadcasts, as taught by "set-top box" in order to increase customer exposure to available products.

There is no system of Daly and Schlasberg. These are two separate documents and, as noted above, there is no motivation to combine these documents to obtain the invention as claimed. In addition, the reason indicated in the Office Action to further combine "set-top box" with Daly and Schlasberg, namely to increase customer exposure to available products, is not found in "set-top box" and does not appear to be found in Daly or Schlasberg. Thus, there is no motivation to combine the cited documents. If the Examiner reasserts this rejection, Applicant respectfully requests that the Examiner specify where in the cited documents one can find a motivation to combine the cited documents.

Claim 17 included limitations similar to claim 9. Therefore, at least for the reasons cited above, claims 9 and 17 are patentably distinct over Daly in view of Schlasberg and further in view of "set-top box" and the rejection of claims 9 and 17 under 35 USC 103 as unpatentable over Daly in view of Schlasberg and further in view of "set-top box" is traversed.

Claim 19 includes limitations similar to claim 10. Claim 20 depends on claim 19. Therefore, at least for the reasons cited above, claims 19 and 20 are patentably distinct over the cited documents.

Applicants believe that this application is in condition for allowance and respectfully request entry of this amendment and allowance of the application. This amendment does not introduce new matter. If there are any questions regarding this amendment and these remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

The Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 14688-504.

Respectfully submitted,



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Boston, MA 02111  
Telephone 617/348-3005  
Attorney for Applicant

Date: October 17, 2002

**APPENDIX A**

**Version of Claim Amendments with Markings to Show Changes Made**

15. (Amended)      The system of claim 11 , wherein the fulfillment system communicates with consumers using multiple transmission mediums.
16. (Amended)      The system of claim 15, wherein the storing means further stores information relating to a consumers access to multiple transmission mediums.
17. (Amended)      The system of claim 11, wherein each remote device comprises:  
storing means for storing a set of previously broadcasted messages for a predetermined period of time.
18. (Amended)      The system of claim 11, wherein the remote device is a set-top box.